



**UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

*Oh*

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/619,643 07/19/00 FISHER

D 38-21(51230)

EXAMINER

HM12/0126

LAWRENCE M LAVIN JR ESQ  
MONSANTO COMPANY  
PATENT DEPARTMENT E2NA  
800 N LINDBERGH BOULEVARD  
ST. LOUIS MO 63167

GOLDBERG, J

ART UNIT

PAPER NUMBER

1655

DATE MAILED:

*H*  
01/26/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/619,643

Applicant(s)

FISHER ET AL.

Examiner

Jeanine A Enewold Goldberg

Art Unit

1655

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 19 July 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 1-7 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claim 1, drawn to a nucleic acid molecule, classified in class 536, subclass 23.6.
  - II. Claim 2, drawn to a maize protein, classified in class 530, subclass 376.
  - III. Claims 3-7, drawn to a transformed plant, classified in class 800, subclass 295.
2. The inventions are distinct, each from the other because of the following reasons:
  - A) The inventions are distinct, each from the other because of the following reasons:

The inventions of Groups I, II, III are patentably distinct because they are drawn to different products having different structures and functions. The nucleic acid of Group I is composed of nucleotides linked in phosphodiester bonds and arranged in space as a double helix. The polypeptide of Group II is composed of amino acids linked in peptide bonds and arranged spatially in a number of different tertiary structures including alpha helices, beta-pleated sheets, and hydrophobic loops (transmembrane domain). The transgenic plant of Group III is a composition made up of structurally and functionally complex biological systems.

Furthermore, the products of Groups I, II, III, can be used in materially different processes, for example, the DNA of Group I can be used in hybridization assays, the polypeptide of Group II can be used to make fusion protein with an enzymatic function, while transgenic plants can be used to express different proteins other than maize proteins. Consequently, the reagents,

reaction conditions, and reaction parameters required to make or use each invention are different. Therefore, the inventions of Groups I, II, III are patentably distinct from each other.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by the different classifications and their divergent subject matter, restriction for examination purposes as indicated is proper.

**Sequence Restriction Requirement Applicable to All Groups:**

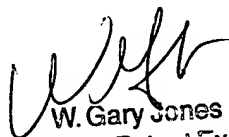
4. In addition, each Group detailed above reads on patentably distinct sequences. Each sequence is patentably distinct because they are unrelated sequences and a further election is applied to each Group. For an elected Group drawn to amino acid sequences, the Applicants must further elect a single amino acid sequence. For an elected Group drawn to nucleotide sequences, the Applicants are permitted to elect up to 5 nucleic acid sequences (See MPEP 803.04).

The claims contain more than ten individual, independent and distinct nucleotide sequences in alternative form. Accordingly, these claims are subject to restriction under 35 U.S.C. 121 as outlined in 1192 O.G. 68 (November 19, 1996).

Applicant is required to select no more than five of the individual sequences for examination. The search of the no more than five selected sequences may include the complements of the selected sequences and, where appropriate, may include subsequences within the selected sequences (e.g., oligomeric probes and/or primers).

5. A telephone call was made to Linda Parker on January 22, 2001 to request an oral election to the above restriction requirement, but did not result in an election being made.
6. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).
7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Jeanine Enewold Goldberg whose telephone number is (703) 306-5817. The examiner can normally be reached Monday-Thursday from 7:00AM to 4:30 PM.  
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jones, can be reached on (703) 308-1152. The fax number for this Group is (703) 305- 3014.  
Any inquiry of a general nature should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Jeanine Enewold Goldberg  
January 22, 2001

  
W. Gary Jones  
Supervisory Patent Examiner  
Technology Center 1600  
1/25/01